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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,717	09/30/2003	Paul Blair	20375-042000	3445

20350 7590 03/04/2005

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EXAMINER

REAGAN, JAMES A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/676,717

Applicant(s)

BLAIR ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Status of Claims**

1. This action is in response to the application filed on 30 September 2003.
2. Claims 1-21 have been examined.

**Information Disclosure Statement**

3. The Information Disclosure Statement filed on 05 January 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

**Claim Rejections - 35 USC § 101**

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

5. Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the recited steps of merely receiving, associating, sending, etc., does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed without the use of any technological apparatus, system or method such as, for example, a computer system, database, electronic circuit, or software application. These steps only constitute a method that is easily attainable without the use of any state-of-the-art devices or techniques.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. *["Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.]*

In the present case, the steps of claims 1 and 13 do not produce and results at all.

#### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosiba et al. (US 6,098,052 A) in view of Piumelli et al. "Power Collecting" (c) 1998.

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1, 13, and 17:**

Kosiba, in at least the abstract and column 1, line 15 to column 2, line 8, as well as other associated and relevant text throughout the reference, discloses the collection process for collecting past due payments. Piumelli, in at least chapter three as well as other associated and relevant text throughout the reference also discloses a collection system. The combination of Kosiba/Piumelli, therefore, discloses the following limitations:

- *receiving a promise-to-pay record from a lender;*
- *receiving a payment from the consumer;*
- *associating the payment with the promise-to-pay record; and*
- *sending a notice to the lender, the notice comprising an indicator that the payment has been received;*
- *receiving a promise-to-pay from the customer;*
- *creating a promise-to-pay record, the promise-to-pay record including a payment amount and an expiration;*

- *transmitting the promise-to-pay record to a payment service provider, the payment service provider adapted to accept a cash payment from the customer if the customer attempts payment prior to the expiration; and*
- *receiving a notice of payment from the payment service provider if the payment service provider received from the customer a payment that equals or exceeds the payment amount.*
- *the customer comprises a borrower, and the promise-to-pay comprises a promise to pay a delinquent amount owed by the borrower;*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kosiba/Piumelli because each discloses collection techniques and strategies.

The combination of Kosiba/Piumelli does not specifically disclose an expiration. However, it is long-standing and recognized in the collection arts that each promise to pay also includes a date in which the payment is to be received, thereby encouraging debtors to pay as quickly as possible. Without further tarnishing their credit or incurring further interviews with the debt collection authority.

**Claim 2:**

With regard to the limitation of *storing a record of the payment in a database*, Kosiba discloses a database in at least Figure 1b and associated text.

**Claims 3 and 16:**

The combination of Kosiba/Piumelli discloses the collection system as shown in the rejections above. Kosiba/Piumelli do not disclose:

- *electronically sending at least a portion of the payment to the lender*
- *electronically receiving the payment amount from the payment service provider*

However, the Examiner takes **Official Notice** that it is old and well known in the collection arts to electronically transfer money to a lender after the collection has been made. This practice provides incentive for the lender to pursue delinquent collection through a collection agency.

**Claims 4, 5, 18, and 19:**

The combination of Kosiba/Piumelli discloses the collection system as shown in the rejections above. Kosiba/Piumelli do not disclose:

- *receiving the payment comprises receiving the payment if the consumer provides a transaction identifier;*
- *associating the payment with the promise-to-pay record comprises matching the consumer-provided transaction identifier with the promise-to-pay record*
- *creating a transaction identifier associated with the promise-to-pay record*
- *providing the transaction identifier to the customer*

However, the Examiner takes **Official Notice** that it is old and well known in the collection arts to assign transaction identifiers to payments as well as conversations to ensure proper documentations and reduce errors during the collection process.

**Claim 6:**

With regard to the limitation of *the promise-to-pay record comprises a time limit, and wherein associating the payment with the promise-to-pay record comprises accepting the payment if receiving the payment occurs within the time limit*, see the rejections of claims 1 and 13 above.

**Claims 7, 8, 20, and 21:**

The combination of Kosiba/Piumelli discloses the collection system as shown in the rejections above. Kosiba/Piumelli do not disclose:

- *sending a request for instructions to the lender if the time limit expires;*
- *sending a request for instructions to the lender if the consumer attempts payment after the time limit expires*
- *receiving a request for instructions from the payment service provider*
- *providing the payment service provider with an instruction in response to the request for instructions*

However, the Examiner takes **Official Notice** that it is old and well known in the collection arts to request continuing guidance regarding delinquent accounts to ensure that the lender's requirements are met.

**Claims 9-11:**

The combination of Kosiba/Piumelli discloses the collection system as shown in the rejections above. Kosiba/Piumelli do not disclose:

- *receiving the promise-to-pay record comprises electronically receiving the promise-to-pay record, and receiving the payment comprises physically receiving the payment;*
- *the payment comprises a cash payment;*
- *the payment comprises a debit card payment;*

However, the Examiner takes **Official Notice** that it is old and well known in the communication arts to send email because it is fast and reliable. In addition, the Examiner takes **Official Notice** that it is old and well known in the collection arts to accept various forms of payments because one may be more efficient than the other.



**Claim 12:**

The combination of Kosiba/Piumelli discloses the collection system as shown in the rejections above. Kosiba/Piumelli do not disclose *comprising verifying a consumer identity prior to receiving the payment*. However, It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kosiba/Piumelli to include an identification step because this would ensure that payments to delinquent accounts are properly handled.

**Claims 14 and 15:**

The combination of Kosiba/Piumelli discloses the collection system as shown in the rejections above. Kosiba/Piumelli do not disclose:

- *updating the promise-to-pay record with the notice of payment*
- *receiving a notice of non-effective payment from the payment service provider, and updating the promise-to-pay record with the notice of non-effective payment.*

However, It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kosiba/Piumelli to include an update step because this would ensure that payments to delinquent accounts are properly handled.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

**(703) 305-7687** [Official communications; including

After Final communications labeled "Box AF"]

**(703) 308-1396** [Informal/Draft communications, labeled "PROPOSED"

or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

JAR

02 March 2005

